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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/398,665	09/17/1999	KARL L. GINTER	7451.0005-01	1372

22852 7590 01/27/2003

FINNEGAN, HENDERSON, FARABOW, GARRETT &  
DUNNER LLP  
1300 I STREET, NW  
WASHINGTON, DC 20006

EXAMINER

BARRON JR, GILBERTO

ART UNIT	PAPER NUMBER
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2132

DATE MAILED: 01/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/398,665

Applicant(s)

GINTER ET AL.

Examiner

Gilberto Barrón Jr.

Art Unit

2132

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 118-120 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 118-120 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10.

- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Cover Sheet for paper # 12

***Response to Amendment***

1. The Amendment originally filed February 27, 2002 has been entered and carefully considered. However, due to this Amendment canceling all previous claims and presenting new claims for this application, new grounds of rejection are invoked.
2. Claims 118-120 are described as identical to claims 207-209 in parent application 08/699,712 (now abandoned) and were indicated as allowable in the parent. After consideration of the new claims and updating the field of search and reviewing the prior art of record, it is determined that further prosecution is necessitated. The new grounds of rejection are presented below.
3. This action is made FINAL as although the newly presented claims were presented in a parent application, these new claims are new to the instant application and distinctly claim subject matter not within the scope of the previous claims.

***Claim Rejections - 35 USC § 112***

4. Claims 118-120 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The instant claims are newly presented and the Amendment does not provide a reference to where support for the subject is found in the disclosure. A response to this rejection should indicate by page and line of the specification and figures, if appropriate, where the description of the claimed invention is found.

5. Claims 118-120 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The instant claims are vague as to the meaning of "virtual entity". Further, it is not clear how the independent claim 118 distinguishes "one or more said trusted electronic commerce nodes securely creating one or more digital credentials" from the next structural limitation of "a digital credentialing arrangement", i.e., what is the difference between the digital credentialing arrangement and the one or more nodes that create the digital credentials?

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 118-120 are rejected under 35 U.S.C. 102(b) as being anticipated by Fischer (US PAT NO. 4,868,877).

The Fischer patent discloses a digital certificate that includes identification and requirement for co-signatures to authorize a particular action or transaction. See column 12, line 19 to column 13, line 55.

To the extent the instant claims are understood, plural distributed trusted electronic commerce nodes are identified in Fischer as parties A, B, etc.. A digital credential arrangement is disclosed by the creation of a certificate shown in Figure 5.

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The secure communication system is the transmission of the certificate to the necessary party. And the system employs the certificate to participate in at least one commercial process, see column 4, lines 30-38.

The virtual entity is the entity formed from the signature and co-signature requirements of the certificate.

Claim 119 is anticipated since the example given in Fischer of a monetary limit is separate from the actual certificate; see column 13, lines 40-55.

Claim 120 is anticipated since one party A or B may stipulate the co-signature requirements; see column 13, lines 55-65.

#### ***Information Disclosure Statement***

8. The Supplemental IDS filed November 19, 2002 has been considered. Several citations contain undated references. Applicant is requested to provide any additional information that may help in dating these references.

9. The IDS includes a sentence that "Additional copies will be submitted on request." If Applicant is able to submit a compilation of the references on an electronic format (CD-ROM), such a resource would be greatly appreciated.

#### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gilberto Barrón Jr. whose telephone number is (703) 305-1830. The examiner can normally be reached on Mondays thru Thursdays from 8:00 AM to 5:00 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, Mr. Albert Decady, who can be reached on (703) 305-9595, or Ms. Gail Hayes, who can be reached on (703) 305-9711, may be contacted for assistance.

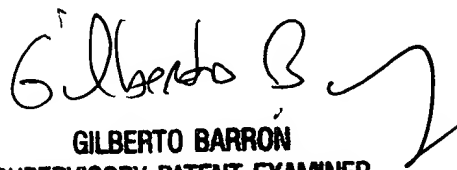
The fax phone number for OFFICIAL responses for the organization where this application or proceeding is assigned is (703) 746-7239.

The fax phone number for AFTER FINAL responses for the organization where this application or proceeding is assigned is (703) 746-7238.

The fax phone number for DRAFT proposals for the organization where this application or proceeding is assigned is (703) 746-7240

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

  
GILBERTO BARRÓN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100



PATENT  
Customer Number 22,852  
Attorney Docket No. 07451.0005-01  
InterTrust Ref. No.: IT-7.1 (US)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: )  
)  
Karl L. GINTER et al. ) Group Art Unit: 2132  
)  
Serial No.: 09/398,665 ) Examiner: G. Barron, Jr.  
)  
Filed: September 17, 1999 )  
)  
For: TRUSTED INFRASTRUCTURE )  
SUPPORT SYSTEMS, METHODS )  
AND TECHNIQUES FOR SECURE )  
ELECTRONIC COMMERCE, )  
ELECTRONIC TRANSACTIONS, )  
COMMERCE PROCESS CONTROL )  
AND AUTOMATION, DISTRIBUTED )  
COMPUTING, AND RIGHTS )  
MANAGEMENT )

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Technology Center 2100

Assistant Commissioner for Patents  
Washington, DC 20231

Sir:

NOTICE REGARDING RELATED LITIGATION

Applicants hereby notify the U.S. Patent and Trademark Office that several patents assigned to InterTrust Technologies Corporation ("InterTrust") are involved in litigation. The present application, Serial No. 09/398,665, is a continuation of U.S. Application Serial No. 08/699,712, now abandoned, which is a continuation-in-part of U.S. Application Serial No. 08/388,107 (the '107 application), now abandoned. The '107 application is the parent of U.S. Patent Nos. 6,389,402 B1; 6,253,193 B1; 6,185,683 B1; 5,982,891; 5,949,876; 5,917,912; 5,915,019; and 5,892,900, which are at issue in the litigation.

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1/23/03